



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/648,216

08/27/2003

Steven S. Kan

MR1957-780

9648

4586 7590 04/27/2007

ROSENBERG, KLEIN & LEE  
3458 ELLICOTT CENTER DRIVE-SUITE 101  
ELLICOTT CITY, MD 21043

EXAMINER

DUNHAM, JASON B

ART UNIT

PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

04/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/648,216	Applicant(s) KAN, STEVEN S.	
	Examiner Jason B. Dunham	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's filing containing the abstract in English and copy of Taiwan patent number 498,240 dated May 31, 2006 in response to the examiner's requirement for information under 37 CFR 1.105 is noted. Applicant amended claims 2,5,6,8-22, and 24-25 and canceled claim 23 in the response filed January 6, 2006. Applicant's amendment to claim 9 rendered the previous objection moot.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger (U.S. Patent No. 6,414,694).**

Referring to claim 1. Berger discloses a method for on-line outsourcing of customized merchandise containing a personalized logo, wherein a remote customer computer in a network environment is connected to a server to customize a piece of tangible merchandise containing at least a personalized logo and the server outsources production of the tangible merchandise to a supplier; the method comprising the steps of:

- Providing a logo image database at the server, wherein the logo image database stores a plurality of first constituent image parts for each of a plurality of logo images, a portion of the plurality of first constituent image parts for each logo image being combined by the server to define at least one default logo image and a plurality of first attributes corresponding to the plurality of first constituent image parts representing characteristics of the first constituent image parts (Berger: abstract and column 1, line 65 – column 2, line 28);
- Providing a merchandise image database at the server, wherein the merchandise image database stores a plurality of second constituent image parts corresponding to at least one default merchandise image and plurality of second attributes corresponding to the plurality of second constituent image parts representing characteristics of the second constituent image parts (Berger: abstract); The examiner notes that Berger discloses displaying articles such as bags, luggage, etc. (Berger: column 1, line 65 – column 2, line 28).
- Personalizing a preferred logo image on the server by the remote customer computer, the remote customer computer selecting a multiplicity of the first constituent image parts and respective ones of the plurality of first attributes stored in the server's logo image database through the network (Berger: abstract and column 3, lines 30-58); Berger discloses a customer drawn graphic prepared by the client or supplier through the use of CAD.
- Customizing a preferred merchandise image on the server by the remote customer computer, the remote customer computer selecting at least one second

constituent image part and at least one second attribute stored in the server's merchandise image database through the network (Berger: abstract and column 1, line 65 – column 2, line 28);

- The server generating a customized product image by combining the customized merchandise image and the personalized logo image and the corresponding first and second attributes selected by the remote customer computer (Berger: abstract); The examiner notes that Berger further discloses sizing the graphical images (Berger: column 7, lines 15-17).
- The server transmitting the generated customized product image to a supplier for the production of at least a piece of tangible, customized merchandise according to the customized product image (Berger: abstract).

Referring to claim 2. Berger further discloses a method wherein the network environment includes at least one of the Internet, a local area network, a proprietary network and a wireless communication network (Berger: column 1, lines 5-10).

Referring to claim 3. Berger further discloses a method wherein said logo image consists of at least one of digitized alphabet, number, symbol, and picture presented in 2-D or 3-D manner (Berger: column 1, line 65- column 2, line 29).

Referring to claim 4. Berger further discloses a method wherein said logo means a business or non-profit entity's identity logo, trademark, server mark, or icon representing a product, a work, a service, a character, or an activity (Berger: column 1, line 65- column 2, line 29 & column 5, lines 5-26).

Referring to claim 5. Berger further discloses a method wherein each said first attribute has a unique code (Berger: figure 2 & figure 3, step 326).

Referring to claim 6. Berger further discloses a method wherein said first attributes are further grouped into a plurality of categories corresponding to distinct attributes including at least one of shape, style, pattern, special effect, contour, color, material, size, and production technique (Berger: column 6, line 52- column 6, line 32 & figure 7).

Referring to claim 7. Berger further discloses a method wherein said merchandise image is digitized, 2-D or 3-D, image representing a piece of tangible merchandise (Berger: column 6, line 52- column 6, line 32 & figure 7).

Referring to claim 8. Berger further discloses a method wherein said second attributes are further grouped into a plurality of categories corresponding to distinct attributes including at least one of shape, style, pattern, special effect, contour, color, material, size, and production technique (Berger: column 6, line 52- column 6, line 32 & figure 7).

Referring to claim 9. Berger further discloses a method wherein said production technique category includes stitching (Berger: column 1, lines 12-34).

Referring to claim 10. Berger further discloses a method wherein each said second attribute has a unique code (Berger: column 6, lines 3-19 & figure 6).

Referring to claim 11. Berger further discloses a method including a step of authorizing a request from the remote customer computer for on-line logo personalization (Berger: figure 5).

Referring to claim 12. Berger further discloses a method wherein said personalized logo image has a unique identification code consisting of a unique code of each first attribute selected (Berger: column 7, lines 57- column 8, line 19).

Referring to claim 13. Berger further discloses a method including a step of displaying the personalized logo image generated by the server on the remote customer computer to obtain a confirmation of the logo personalization there from (Berger: column 7, lines 44-56 & figure 9).

Referring to claim 14-16. Claims 14-16 are rejected under the same rationale set forth above.

Referring to claim 17. Berger further discloses a method comprising the steps of:

- Receiving, by the server, the remote customer's upload of an edited or self-designed first attribute for a logo image or second attribute for a merchandise image (Berger: column 3, lines 30-58 & figure 1); and
- The server storing in corresponding logo image or merchandise image database, after approval, said edited or self-designed first or second attribute (Berger: column 3, lines 30-58 & figure 1).

Referring to claim 18. Berger further discloses a method including a step of receiving an indication from the remote customer computer of at least one preferred location and size of said personalized log image to be combined with the customized merchandise image (Berger: column 7, lines 32-56 & figure 8-9).

Referring to claim 19. Berger further discloses a method including a step of displaying said customized product image to obtain a confirmation from the remote

customer computer of the preferred location and size (Berger: column 7, lines 44-56 & figure 9).

Referring to claim 20. Berger further discloses a method wherein said customized product image has a unique identification code set consisting of the unique identification codes of the customized merchandise and personalized logo images (Berger: column 7, lines 57- column 8, line 19).

Referring to claim 21. Berger further discloses a method comprising the steps of:

- Providing an outsourcing database at the server for storing business information of at least one of the supplier and data of outsourcing invoice records (Berger: column 8, lines 1-19); and
- Providing a customization order database at the server for storing data of customization data records (Berger: column 8, lines 1-19).

Referring to claim 22. Berger further discloses a method including a step of the server receiving a confirmation from the remote customer computer for the outsourcing of production of said tangible, customized merchandise according to the said customized product image (Berger: column 8, lines 1-19).

Referring to claim 24. Berger further discloses a method wherein said outsourcing invoice record includes an outsourcing case number, the unique identification code set of the customized product image, and information of the unit price, the ordered quantity, the total amount, the name and address for delivery, and the deadline of delivery (Berger: column 8, lines 1-19 and figure 3, step 334).



Art Unit: 3625

Referring to claim 25. Berger further discloses a method wherein said customization order record comprises a customization order number, the outsourcing case number, the unique identification code set of the customized product image, and information of the unit price, the ordered quantity, the total amount, the name and address for delivery, and the deadline of delivery (Berger: column 8, lines 1-19 and figure 3, step 334).

Referring to claim 26. Claim 26 is rejected under the same rationale set forth above.

### ***Response to Arguments***

Applicant's arguments filed January 6, 2006 have been fully considered but they are not persuasive. Applicant argues that Berger only allows attributes of the logo such as color or size to be varied and does not disclose image parts being combined to create a logo. The examiner disagrees, noting that while Berger does disclose predetermined images of articles (such as bags, luggage, etc.), customization of graphics (such as logos) is permitted. Column 3, lines 53-58 and figure 1 of Berger disclose: "Other data-input devices including a graphics CAD package, **operated as part of the supplier's system, can be linked to the server**, and used to input image data. Such a program can be operated by the system administrator 120 or by another terminal/computer linked to the server 116." Clearly, Berger allows parts of a graphical image to be designed and a customized personal logo to be formed for placement on a

Art Unit: 3625

predetermined article. The dependent claims of claim 1 are rejected under the same rationale.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD  
Patent Examiner  
4/16/07



YOGESH C. GARG  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600